

**MAY 05 2011**

*In the United States Patent and Trademark Office*

Appn. Number: 09/641,410  
Appn. Filed: August 18, 2000  
Applicant: Alice Mary O'Donnell Kiely  
Title: Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards  
Examiner/GAU: Keith Hendricks/Joyti Chawla 1794

Yorktown Heights, NY May 5, 2011

**REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.181**

Assistant Commissioner for Patents

Arlington, Virginia 22313

Office of Petitions

Attn: Mr. Brian Brown

Sir:

Applicant respectfully requests reconsideration for the withdrawal of the holding of abandonment for Application Serial Number 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards.

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**Request for Reconsideration To Withdraw Holding of Abandonment  
Based on Premature Final Office Action Under 37 CFR 1.181**

This correspondence is in regard to U.S. Patent Application Serial Number 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards.

Applicant's Petitions to Withdraw the Holding of Abandonment of 3/29/2010, 12/16/2010, 12/29/2010 and 12/30/2010 are incorporated into this document by way of reference.

Applicant is currently in receipt of a decision on a Petition to Withdraw the Holding of Abandonment of this application. The decision is **DISMISSED** as moot.

The ground for this decision being:

As correctly noted by the Technology Center Director, the filing of an amendment after final rejection does not stop the running of the statutory period or reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Therefore, a Notice of Abandonment was mailed February 3, 2010. As the application is now abandoned, the petition to overturn the decision of the Technology center Director is DISMISSED as moot.

In response, Applicant disagrees and respectfully submits that Applicant's Request to Withdraw the Holding of Abandonment of Application SR No. 09/641,410 Edible Supports for Comestibles is not moot, but quite material.

In order for an "Abandonment" to be valid, Applicant had had to be sent a full and fair unbiased Office Action(s).

**MPEP 706.07** - Thus examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing...)

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The record shows that both Office Actions of **10/16/2008** and **7/9/2009** were based solely upon prejudice and thus were not valid Office Actions.\* Consequently, the finality of the Office Action is ineffectual and the said abandonment of the application is factually non-existent. [emphases added]

Accordingly, Application Serial No. 09/641,410 Edible Supports for Comestibles is thus NOT abandoned. Applicant further respectfully submits that as the decision of "DISMISSED as moot" was in response to Applicant's petitions which pointed out this documented prejudice, the decision, based upon this information, has thus compounded the noted prejudice.

Contrary to the Office, Applicant is NOT required to beg for a full and fair examination of claims 383 - 416 from the United States Patent and Trademark Office. [emphasis added] (see at least MPEP 706.07 - Thus examiner should never lose sight of the fact that *in every case the applicant is entitled to a full and fair hearing...*), (35 U.S.C. 101 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, may obtain a patent therefor...), (35 USC 102; A person shall be entitled to a patent unless...by the other.)

Contrary to the Office, Applicant is NOT required to beg for the merits of claims 383 - 494 to be properly examined, which were stated to be understood by the Patent and Trademark Office. MPEP 707.07(j). (see Applicant's Petitions where the Office states: "*in fact since the edible support is disclosed as being a composite...*")

The Office furthermore has unlawfully withdrawn method and means claims (403 - 416) without a prima facie showing of being patentably distinct from claims 383 - 402. (35 U.S.C. Section 112 paragraph 6; 35 U.S.C. 101)

The Office has denied a patent to Applicant having patentable subject matter at least through continuous and intentional failure to consider the merits of claims 383 - 402 which were known to the Patent and Trademark Office, the unjust withdrawal of claims 403 - 416 from examination, and the repeated requirement for Applicant to cancel Applicant's patentable subject matter, as a

condition of the examination for a patent. (See petitions and Office Actions from the Office) (MPEP 707.07(j))

\* Office Action of 10/16/2008 stated:

**1) Amendments to Specification:**

The term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to "a composite material candy bar" in paragraph [0164] which is not the same as a generic term "candy bar" as originally described. Therefore, the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

**2) 35 USC section 112, (first paragraph):**

The term "composite material" as added to the claims introduces new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" changes the description of "a candy bar" to "a composite material candy bar," which is not the same as a generic term "candy bar" as originally described. ... Therefore, the amendments to the claims introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

Contrary to the requirement of the Patent Office, Applicant is NOT required to cancel Applicant's patentable subject matter as a condition of the examination. [emphasis added] Requiring Applicant to cancel Applicant's patentable subject matter in reply to this Office Action is clearly prejudicial.

**Final Rejection of 7/9/2009 stated:**

**1) Amendments to Specification**

... The term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to "a composite material candy bar" in paragraph [0164], which is not the same as a

generic term "candy bar" as originally described. Therefore, the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

### **2) 35 U.S.C. Section 112, first paragraph**

In the instant case the term "composite material" as added to the claims introduces new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" changes the description of "a candy bar" to "a composite material candy bar", which is not the same as a generic term "candy bar as originally described.

Applicant was again required to cancel Applicant's patentable subject matter. This is clearly unlawful and prejudicial. Applicant is NOT required to cancel Applicant's patentable subject matter in reply to the Office Action.

**N.B.** This prejudice has recently been conceded by the Patent and Trademark Office by the entry of Applicant's term "composite material" into the specification and the claims in dependent application SR No. 11/903,722, Method of Supporting a Comestible. (Final Rejection on 9/15/2010 - Exhibit A)

This is confirmation by the Patent and Trademark Office that the Office Actions of 10/16/2008 and 7/9/2009 were both indeed prejudicial. Thus, Application SR No. 09/641,410 was in fact never abandoned.

### **3) Election/Restriction**

Since applicant had elected a product and not the method of making in response to the election requirement the method of making the product, i.e. claims 370-382 are withdrawn from consideration as being directed to a non-elected invention.

The withdrawal of Applicant's method and means claims by the Office was prejudicial and in

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direct conflict with the acknowledgment of such method claims and such means claims. These claims were examined by the Patent and Trademark Office, as is, in the first Office Action on the merits for Applicant's claims on 5/23/2003. As far as applicant is aware, the method and means claims are not to be withdrawn from examination without specific documented prima facie evidence of being patentably distinct, of which no evidence had ever been sent to Applicant.

According to the record, the Office Action of 7/9/2009 was also unjustly made final having introduced a new reference to Lane (1,690,984) which was not due to an amendment of applicant nor an IDS. (MPEP 706.07(a) "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.117(p))." (Page 8-9 of Petition of 12/16/2010) Authorities as to law and the MPEP may be relied upon by Applicant and MUST not be ignored.

### 35 U.S.C. Section 102

Claim 383 recites:

A non-frozen support for a frozen comestible comprising an edible confectionary material comprising two ingredient materials within said edible confectionary material or two constituent materials.

In the Office Action of 10/16/2008, claim 383 had been rejected on the ground of:

Musher teaches ice cream (frozen comestible) on an edible support structure or a composite support which has at least two edible discernable (i.e. perceptible) edible materials or components or members that are combined together to make the support, i.e., two combined ingredient materials. (Page 1; Column 1, lines 37-46 and Column 2 lines 40-55) also (Page 4: column 1, line 72 to Column 2, line 23 as instantly claimed.